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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/747,616	12/30/2003	Kothapalli Venkata Surya Narayana Raju	C261 1040.1	2874
26158	7590	01/24/2006	EXAMINER	
WOMBLE CARLYLE SANDRIDGE & RICE, PLLC			CHEN, VIVIAN	
P.O. BOX 7037				
ATLANTA, GA 30357-0037			ART UNIT	PAPER NUMBER

1773

DATE MAILED: 01/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/747,616

Applicant(s)

RAJU ET AL.

Examiner

Vivian Chen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 4-7 is/are pending in the application.
- 4a) Of the above claim(s) 5-7 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 4 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 12/30/03.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

1. Claims 3, 8-20 have been cancelled by Applicant

### ***Response to Election/Restrictions***

2. Applicant's election of Group I (claims 1-2, 4-7) and species (a)(1) in the reply filed on 11/4/2005 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

3. Claims 5-7 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 11/4/2005.

### ***Specification***

1. The use of numerous trademarks and tradenames has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-2, 4 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 1 recites numerous trademarks and/or tradenames (e.g., Nilset117, HapcoNXZ, etc.) which are not adequately described or specified in the specification as originally filed. The specification fails to provide any information or generic terminology (e.g., chemical composition, function, etc.) which would adequately identify the recited compounds to one of ordinary skill in the art.

5. Claims 1-2, 4 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 1 recites numerous trademarks and/or tradenames (e.g., Nilset117, HapcoNXZ, etc.) which are not adequately described or specified in the specification as originally filed. The specification fails to provide any information or generic terminology (e.g., chemical

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composition, function, etc.) which would adequately identify the recited compounds to one of ordinary skill in the art.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-2, 4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites numerous trademarks and/or tradenames (e.g., Nilset117, HapcoNXZ, etc.) which are not adequately described or specified in the specification as originally filed. The specification fails to provide any information or generic terminology (e.g., chemical composition, function, etc.) which would adequately identify the recited compounds to one of ordinary skill in the art.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-2, 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over KYMINAS ET AL (US 4,749,731) in view of KUO ET AL (US 2003/0195292).

KYMINAS ET AL discloses a coating composition comprising a polymeric binder and a pigment content of 20-60 wt%, wherein the coating composition typically contain 3-25 wt% titanium dioxide, 5-30 wt% talc, and 1-25 wt% calcined clay. (line 50-62, col. 4; line 45-66, col. 5; line 25-38, col. 6) However, the reference does not explicitly recite an alkyd resin binder.

KUO ET AL '292 discloses that it is well known in the art to utilize alkyd-based resins as binders in pigmented coating compositions in order to form durable coatings for substrates. The reference further discloses that it is well known in the art to incorporate various additives (e.g., anti-settling agents, dispersing agents, extenders, etc.) in alkyd-based coating compositions in order to enhancing the performance and coating characteristics of the coatings. (paragraphs 0033-0040).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize known, high-durability resin binders such as alkyd resins in the coating compositions of KYMINAS ET AL in order to form weather-resistant pigmented surface coatings. It also would have been obvious to use effective amounts of known performance-enhancing additives in the coating compositions in order to improve the coating characteristics of the composition and the physical properties of the resultant coating.

10. Claims 1-2, 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over:  
KUO ET AL (US 2003/0195292) or KUO ET AL (US 2002/0183453),  
In view of KYMINAS ET AL (US 4,749,731).

KUO ET AL '292 and '453 disclose coating compositions containing alkyd-based resin binders and typically 30-60 wt% pigments (e.g., titanium dioxide, barites, clay, etc.), wherein the coating composition further contains various known coating additives (e.g., anti-settling agents, dispersing agents, extenders, etc.). (KUO ET AL '292, paragraphs 0033-0040) (KUO ET AL '453, paragraphs 0026-0038) However, the reference does not explicitly disclose the recited amounts of various pigments.

KYMINAS ET AL discloses that it is well known in the art to incorporate a combination of pigments into a coating composition, wherein the compositions typically contain 3-25 wt% titanium dioxide, 5-30 wt% talc, and 1-25 wt% calcined clay in order to obtain a highly durable protective pigmented coating for exposed surfaces. (line 50-62, col. 4; line 45-66, col. 5; line 25-38, col. 6)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize combinations of known pigments in the coating compositions of KUO ET AL '292 or '453 in order to tailor the the visual appearance, hiding power, durability, and other physical properties of the resultant coatings for specific applications. It also would have been obvious to use effective amounts of known performance-enhancing additives in the coating compositions in order to improve the coating characteristics of the composition and the physical properties of the resultant coating.

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***Conclusion***

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vivian Chen whose telephone number is (571) 272-1506. The examiner can normally be reached on Monday through Thursday from 8:30 AM to 6 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney, can be reached on (571) 272-1284. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

The General Information telephone number for Technology Center 1700 is (571) 272-1700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

January 20, 2006



Vivian Chen  
Primary Examiner  
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